REMARKS

1. Claims 1 - 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakajima (US 6,104,829).

Applicant respectfully submits that the Examiner has failed to establish a prima facie basis for rejection of Claims 1 and 3 under 35 U.S.C. 102(e).

To constitute a "description" of a patented invention within the meaning of 35 USC § 102(e) the prior publication must describe the invention as claimed in full, clear and exact term so as to allow a person skilled in the art to practice the invention. Vague and general representations are not sufficient to support a defense of anticipation under the law. Applicant respectfully submits that the references applied by the Examiner are too vague to support an enabling description under 102(e).

Nakajima discloses a method and apparatus for selecting a print job parameter for instance a color space compression corresponding to a selected recording medium. See US 6,104,829 col. 2, lines 44 - 50. The Examiner relies on Fig. 11 and the associated discussion found at column 12, lines 33 – 58 to support the rejection of Claim 1. The disclosure found at column 12, lines 33 – 58 clearly teaches determining a current color processing method, CCPM, in accordance with a selection table indicating different combinations of output methods and recording media.

Conversely, Applicant claims ascertaining a pre-selected toner density setting and selecting a print media source based upon the pre-selected toner density setting. See Application, Claim 1.

Nakajima fails to teach the claimed invention in full, clear and exact terms and therefore fails to support the rejection of Claim1 under 35 U.S.C. 102(e). Applicant respectfully submits that the rejection of Claim 1 and Claims 2 -and 3, which depend from Claim 1 should be withdrawn and Claims 1 – 3 allowed.

2. Claims 3 - 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima. Applicant respectfully submits, with regard to Claim

3, that insofar as Nakajima fails to teach the claimed invention in full, clear and exact terms and therefore fails to support the rejection of Claim1 under 35 U.S.C. 102(e), that Nakajima therefore also fails as a primary reference under 35 U.S.C. 103(a). Applicant respectfully submits that the rejection of Claim 3 under 35 U.S.C. 103(a) should be withdrawn and Claim 3 allowed.

3. Regarding Claim 4, Nakajima teaches the selection of one of three current color processing methods, (CCPM), based in part on a selection of a print media. In order for the device and/or method of Nakajima to select one of the three current color processing methods to be employed for any particular imaging routine, the method must also ascertain a selected print mode. While the Examiner takes the position that depending on the mode selected draft or normal or quality, it would have been obvious to one of ordinary skill in the art at the time the invention was made that when the draft mode is selected the plain paper is selected and processing is done as shown in Fig. 6, as CPM1. However, the teaching of Nakajima is not so clear. According to Fig. 11, based on the selection of print medium, for example plain paper, any of three print modes may be employed: draft, normal or quality.

According to the claimed invention, a method for selecting a print job parameter includes the steps of ascertaining a pre-selected print media source setting and selecting a toner density setting based upon the pre-selected print media source setting.

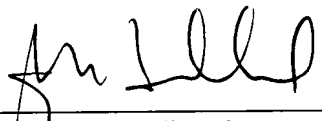
Applicant respectfully submits that the Examiner has failed to establish a prima facie case for rejection of Claims 3 - 6 under 35 U.S.C. 103(a) as being unpatentable over Nakajima. To establish a *prima* facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and must not based on applicant's disclosure. MPEP, *7th ed. Revision 1*, February 2000, § 706.02(j) citing *In re*

Vaek, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The burden lies initially with the Examiner to provide some suggestion of the desirability of doing what the inventor has done. MPEP, *7th ed. Revision 1*, February 2000, § 706.02(j) citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

There would be no motivation eliminating the step of selecting a current color processing method in Nakajima to arrive at the present invention as the teaching of Nakajima is rendered meaningless in light of such an omission as Nakajima teaches printing on any medium in any print mode. See Fig. 11.

Applicant respectfully submits that the rejection of 3 - 6 under 35 U.S.C. 103(a) should be withdrawn and Claims 3 - 6 allowed.

3. Applicant believes the application is in condition for allowance and respectfully requests the same. If the Examiner is of a differing opinion he/she is hereby requested to conduct a telephonic interview with the undersigned attorney.



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